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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,081	10/05/2001	Ok-Hyun Son	P54757RE2	2098
8439	7590	11/24/2004	EXAMINER	
ROBERT E. BUSHNELL 1522 K STREET NW SUITE 300 WASHINGTON, DC 20005-1202			KAPADIA, VARSHA A	
			ART UNIT	PAPER NUMBER
			2651	13
			DATE MAILED: 11/24/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/971,081

**Applicant(s)**

SON, OK-HYUN

**Examiner**

Varsha A Kapadia

**Art Unit**

2651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

This office action is responsive to the amendment filed on June 16, 2003.

### **Recapture Rejections**

Claims 16-17, 20-21, 24, 26, 28, 31,32 and 35-54 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the patent reissue is based. See *Pannu v. Storz*, 258 F. 3d 1366 (Fed. Cir. 2001), See *Hester Industries, Inc. V. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) ; *In re Clement*, 131 F. 3d 1464, 45 USPQ 2<sup>nd</sup> 1161 (Fed. Cir. 1997) ; *Ball Corp. v. United States*, 729 F. 2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In claims 16-17, 20-21, 24, 26, 28, 31,32 and 35-54, applicant has omitted the language "skipping a remaining data address in said different recording locations of said data track, when any one data address mark recorded in said different recording locations is normally detected" and "said transducer head not utilizing a remaining data address mark recorded in said different recording locations of said data track, when a data address mark recorded in a different data address regions is detected". This language specifically added to claims in the original patent to place it in condition for allowance.

### **Allowable Subject Matter**

Claims 1-15 are allowed.

Claims 18-19, 22-23, 25, 27, 29-30 and 33-34 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Response to Arguments**

In regard to applicant's arguments that "forming and processing a data address mark" differ from "a method of providing a data block, describe the step of "writing" rather than step of processing a data address mark". Examiner disagrees because the language "method of providing said data block" wherein "...number or bytes to be ignored when said first data address mark is normally read", as recited in the reissue claims 18-19, show that the method of "providing" encompasses both the writing as well as forming and processing. Applicant's argument that providing is limited to "writing" is undermined by his use of providing in the dependent claims 18-19 to referring to the processing steps. Thus, reissue claims are in fact broader than the original claims 1, 7 and 11.

Similarly, applicant's argument that set of reissue claims define "method of reading a data block, as opposed to "processing a data address mark". Examiner disagree because the language i.e. "method of claim 26 further comprised of "skipping detection" and number of bytes to be ignored..." as recited in the reissue claims 27, 29-30, show that the "method" encompasses both reading as well as processing and forming. Applicant's argument that method

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is limited to "reading a data block" is undermined by his use of method in the dependent claims 27, 29-30 to referring to the processing steps i.e. "skipping detection".

In any event, both sets of claims (1, 7 and 11 as well as reissue claims 16-54) there is a limitation in the body of the claim that is drawn to recording medium having data address marks. The language that was specifically added to claims in the original patent to place it in condition for allowance is not present in the claims presented in the reissue application.

Applicant's remarks on page 8+ of the amendment filed on 29 March 1998 has been fully considered. However, the fact that applicant willingly amended the original claims 1, 7 and 11 to incorporate the language "skipping a remaining data address in said different recording locations of said data track, when any one data address mark recorded in said different recording locations is normally detected" and "said transducer head not utilizing a remaining data address mark recorded in said different recording locations of said data track, when a data address mark recorded in a different data address regions is detected" to place it in condition for allowance and the subsequent omission of such limitation in the reissue claims is presumed to be broadening in an aspect of the reissue claims related to surrendered subject matter. Accordingly, the reissue claims are barred by the recapture doctrine. See M.P.E.P. 1412.02 and 1412.03.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Varsha A Kapadia whose telephone number is (703) 305-4198. The examiner can normally be reached on Mon Tue and Thurs. from 6:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (703) 305- 4040. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VK



**SINH TRAN**  
**PRIMARY EXAMINER**